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MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			O'CONNOR, GERALD J	
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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20070215

Application Number: 09/825,879

Filing Date: April 5, 2001

Appellant(s): Connors et al.

Phillip E. Miller
(Reg. No. 46,060)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal filed November 13, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(International Business Machines Corporation)

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) Status of Claims

The statement of the status of claims contained in the brief is essentially correct.

(Claims 1-13 and 21-26 are pending, rejected, and appealed.)

(Claims 14-20 have been cancelled.)

(Claim 27 remains pending, but stands withdrawn.)

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. (An after-final amendment was filed on Sept. 9, 2005, and was entered.)

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

I. Claims 1-13 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al. (US 6,269,342), in view of Adamec et al. (US 6,211,773).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 6,269,342	Brick et al.	7/2001
US 6,211,773	Adamec et al.	4/2001

(9) *Grounds of Rejection*

I. Claims 1-13 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al. (US 6,269,342), in view of Adamec et al. (US 6,211,773).

Brick et al. disclose a system for restocking and repricing merchandise, comprising: a shelf label holder; and a hand-held unit which remotely programs said shelf label holder, but

the shelf label holder of Brick et al. fails to include an illuminating section which is illuminated by remote control of the hand-held unit under a predetermined condition. However, Adamec et al. disclose a similar system for restocking and repricing merchandise, and the shelf label holder of Adamec et al. indeed includes a plurality of illuminating sections which are illuminated by remote control of the hand-held unit under a predetermined condition (see, in particular, column 4, line 32 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Brick et al. so as to include an illuminating section in the shelf label holder which would be illuminated by remote control of the hand-held unit under a predetermined condition, in accordance with the teachings of Adamec et al., in order to facilitate locating the shelf label holder to be programmed.

Regarding claim 2, the system of Brick et al. includes a host controller for storing merchandise data and planogram data, processing said data and remotely controlling an operation of said hand-held unit and said shelf label holder.

Regarding claims 3 and 24-26, the shelf label holder of Brick et al. includes a shelf control unit, and the shelf label holder of Adamec et al. includes a shelf control unit for controlling an illumination of the shelf label holder; with the illuminating section illuminating as directed by the shelf control unit. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Brick et al. so as to include that the shelf control unit would control illumination of the shelf label holder;

with the illuminating section illuminating as directed by the shelf control unit, in accordance with the teachings of Adamec et al., in order to provide a convenient means of enabling the illumination section of the shelf label holder to be controlled.

Regarding claim 4, the system of Brick et al. includes that an identifying section of said shelf label holder is inserted into said shelf control unit.

Regarding claim 5, the system of Brick et al. includes that the shelf control unit comprises: a receptacle for receiving said identifying section of said shelf label holder; and a transceiver for transmitting signals to said host controller and said hand held unit and receiving signals from said host controller and said hand held unit.

Regarding claim 6, the system of Brick et al. includes that the hand-held unit comprises: a transceiver for transmitting signals to said host controller and said shelf control unit and receiving signals from said host controller and said shelf control unit; a display device for displaying merchandise data and planogram data; at least one of a bar code scanner and a keypad for inputting said data into said hand held unit; and a memory for storing said data.

Regarding claim 7, the system of Brick et al. includes that the host controller comprises: a memory for storing planogram data and merchandise data; a display device for displaying said data; at least one of a bar code scanner and a keypad for inputting said data; and a transceiver for transmitting signals to said shelf control unit and said hand held unit and receiving signals from said shelf control unit and said hand held unit.

Regarding claim 8, the system of Brick et al. includes that the merchandise information comprises vendor information data, pricing data and inventory data, and wherein said planogram data comprises correct merchandise shelf locations.

Regarding claim 9, the system of Brick et al. includes that the host controller transmits planogram data and merchandise data to said hand held unit and said hand held unit displays said data (see, in particular, column 14, line 3 et seq.).

Regarding claim 10, the system of Brick et al. includes that the identifying section comprises at least one of a bar code, a radio frequency identification (RFID) tag, and a magnetic identification tag.

Regarding claim 11, the system of Adamec et al. includes that the illuminating section comprises at least one of a light-emitting diode, an organic light emitting diode, a liquid crystal display element, a plasma display element, an incandescent light bulb, and a light pipe. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the shelf label holder of Brick et al. so as to include that the illuminating section would comprises at least one of a light-emitting diode, an organic light emitting diode, a liquid crystal display element, a plasma display element, an incandescent light bulb, and a light pipe, in accordance with the teachings of Adamec et al., in order to provide a convenient means of providing the illumination for the illumination section.

Regarding claim 12, the system of Brick et al. includes that the signals comprise at least one of a radiowave signal and infrared signal.

Regarding claim 13, the system of Brick et al. includes that the merchandise data comprises merchandise restocking and repricing information.

Regarding claims 21 and 22, the system of Brick et al. includes that the illuminating device comprises LEDs formed along a longitudinal edge of said shelf label holder.

Regarding claim 23, the system of Brick et al. includes that the shelf label holder is connected to one of an upper and lower surface of a shelf for displaying the merchandise.

(10) *Response to Argument*

I. Claims 1-13 and 21-26 are unpatentable under 35 U.S.C. 103(a) for being obvious over Brick et al. (US 6,269,342), in view of Adamec et al. (US 6,211,773).

Regarding the argument that the inventions of Brick et al. and Adamec et al. are different inventions than appellant's invention because the disclosures of Brick et al. and Adamec et al. fail to use the same names for certain elements as the names used by appellant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Regarding the argument that neither Brick et al. nor Adamec et al. explicitly disclose/characterize any element of their respective apparatus as a "holder" for "holding a shelf label," the *functionality* argued by appellant as being performed by appellant's claimed *apparatus* is

merely functional language setting forth the manner in which the apparatus is intended to be employed. While there is nothing inherently improper in defining something by what it *does*, rather than by what it *is*, such functional recitations *do not* differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus includes all the structural limitations of the claim. The functional language is considered merely the intended use for the claimed apparatus, and a recitation of the intended use of the claimed apparatus must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The same intended use need neither be disclosed in, nor inherently performed by, the prior art. As long as the prior art structure is *capable* of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, a shelf label, such as one comprising an adhesive paper label, clearly *could* be stuck onto any of the disclosed apparatus of Brick et al. and Adamec et al., thereby indeed making it a “shelf label holder” by holding the self label, which inherent capability would be all that is required to meet the claimed *apparatus*.

Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941

(Fed. Cir. 1992). In this case, the motivation to combine or modify the prior art would be found in the knowledge generally available to one of ordinary skill in the art.

Furthermore, the combination proposed by the examiner could have been made readily and easily by any person of ordinary skill in the art, at the time of the invention, with neither undue experimentation, nor risk of unexpected results, and it is well settled that such is the main test for the tenability of any conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art knowledge. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

Regarding the argument that Brick et al. and Adamec et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the two references are each both in the field of applicant's endeavor *and* completely pertinent to the particular problem with which applicant was concerned.

Regarding the argument that the Brick et al. and Adamec et al. references are too complex and show too many features for appellant to understand how they could possibly be relevant to appellant's invention, the disclosures of Brick et al. and Adamec et al. are directly on point with respect to appellant's invention, and are considered neither complex nor lengthy to those of ordinary skill in the art.

(II) Related Proceeding(s) Appendix

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor". To the right of the signature is the date "2/15/07".

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

GJOC

February 15, 2007

Appeal Conference Held:

Alex Kalinowski
AK
Supervisory Patent Examiner
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Copy to Appellant:

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